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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,686	06/20/2001	Paul Peterson	30020/37197	6375
4743	7590	06/29/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			THAI, CANG G	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/885,686	PETERSON, PAUL
	<b>Examiner</b>	<b>Art Unit</b>
	Cang G. Thai	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 02/04/2002, 10/07/2002, and 01/26/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,324,545 (MORAG).

As for claim 1, MORAG discloses a method of producing a lenticular novelty item interactively via the Internet, the method comprising the steps of:

transmitting a plurality of graphic images indicative of a plurality of predetermined theme choices from a server to a client device via the Internet {See Column 6, Lines 7-10, wherein this reads over “the acquired images are preferably transmitted to the service provider by digital means, most preferably by computer communications, such as over the Internet”};

receiving a theme identifier at the server from the client device via the Internet, the theme identifier identifying one of the plurality of predetermined theme choices, the identified theme including a foreground image and a background image {See Column 6, Lines 24-25, wherein this reads over "the arrangement of the images is preferably performed, automatically by a computer, at the service provider"};

receiving a digital image at the server from the client device via the Internet {See Column {See Column 6, Lines 10-11, wherein this reads over "the images may also be sent on a storage medium"};

digitally combining at least a portion of the background image, at least a portion of the received digital image, and at least a portion of the foreground image to create a final composite image {See Column 7, Lines 39-40, wherein this reads over "composition instructions, which determines if and how images should be combined into mosaics"};

printing the final composite image to produce a printed image {See Column 6, Lines 35-37, wherein this reads over "this proof copy album may, of course be printed and sent by mail"};

affixing a lenticular surface to the printed image to produce the lenticular novelty item {See Column 9, Lines 51-53, wherein this reads over "transparent and/or opaque images may also be used between images, since the background of the album page usually also contains a pattern or an image"};

receiving a shipping address at the server from the client device via the Internet {See Column 6, Lines 13-15, wherein this reads over "the customer preferably sends

instructions, as described below, regarding how the images should be arranged into the albums"}; and

causing the lenticular novelty item to be shipped to the shipping address {See Column 6, Lines 34-35, wherein this reads over "an electronic proof copy of the album is optionally sent to the customer for approval"}.

As for claim 2, MORAG discloses a method as defined in claim 1, further comprising the step of transmitting a graphical representation of the final composite image to the client device via the Internet {See Column 6, Lines 34-35, wherein this reads over "an electronic proof copy of the album is optionally sent to the customer for approval"}.

As for claim 3, MORAG discloses a method as defined in claim 2, wherein the step of transmitting a graphical representation of the final composite image comprises the step of transmitting data indicative of a plurality of two dimensional frames sequenced to produce a three dimensional illusion representing the final composite image {See Column 6, Lines 42-44, wherein this reads over "the proof copy is maintained at a web site by the service provider, where the customer can browse the proof copy and enter comments"}.

As for claim 4, MORAG discloses a method as defined in claim 1, wherein the step of digitally combining comprises the steps of:

retrieving a composite background image {See Column 9, Lines 49-51, wherein this reads over "labels may have a transparent background or they may have an opaque background"};

retrieving a composite foreground image {See Column 9, Lines 51-53, wherein this reads over "Transparent and/or opaque images may also be used between images, since the background of the album page usually also contains a pattern or an image"};

deleting a portion of the composite background image to create a specialized background image, the portion of the composite background image deleted being dependant on the captured digital image {See Column 10, Lines 41-43, wherein this reads over "after the images are correlated, the images in each group are combined to form a single combination image, by cutting and pasting of image portions"};

deleting a portion of the received digital image to create a specialized interior image, the portion of the received digital image deleted being dependant on the composite foreground image {See Column 10, Lines 43-45, wherein this reads over "alternatively or additionally, images and/or image portions are enlarged, reduced and/or morphed to fit"}; and

digitally combining the specialized background image, the specialized interior image, and the composite foreground image to create the final composite image {See Column 10, Lines 45-46, wherein this reads over "the seam between image portion are smoothed"}.

As for claim 5, MORAG discloses a method as defined in claim 1, wherein the identified theme includes an interior image and the step of digitally combining comprises the step of interleaving the portion of the received digital image with the interior image {See Column 10, Lines 46-48, wherein this reads over "such seams may be specially marked to indicated that two different image portions are utilized"}.

As for claim 6, MORAG discloses a method as defined in claim 1, further comprising the step of printing a lenticular registration mark on the printed image, the lenticular registration mark facilitating rotational positioning of the lenticular surface on the printed image and axial positioning of the lenticular surface on the printed image {See Column 11, Lines 3-4, wherein this reads over “the detail image is printed covering a portion of the overview image”}.

As for claim 7, MORAG discloses a method as defined in claim 1, wherein the step of affixing a lenticular surface to the printed image comprises the step of affixing a lenticular surface including an adhesive material exposed by peeling back a cover layer {See Column 11, Lines 13-15, wherein this reads over “alternatively or additionally, image annotations, such as text labels may be used to match detail images to overview images”}.

As for claim 8, MORAG discloses an apparatus for producing a lenticular novelty item interactively via the Internet, the apparatus comprising:

a network receiver structured to receive a theme identifier and a digital image, the theme identifier identifying one of a plurality of predetermined themes {See Column 5, Lines 8-9, wherein this reads over “a network connector, adapted to receive data from a computer network”};

a memory device operatively coupled to the network receiver, the memory device storing a foreground image, an interior image, and a background image associated with the identified theme {See Column 5, Lines 10-11, wherein this reads over “an image

store, which receives and stores a plurality of digitally encoded images from said network"};

an integration module operatively coupled to the network receiver and the memory module, the integration module being structured to combine at least a portion of the background image, at least a portion of the received digital image, at least a portion of the interior image, and at least a portion of the foreground image to create a final composite image {See Column 5, Lines 12-13, wherein this reads over "an image arrange which generates an arrangement of images, for an album, for said plurality images"}; and

a printer driver operatively coupled to the integration module, the printer driver being structured to cause a printer to print the final composite image {See Column 5, Lines 26-27, wherein this reads over "alternatively or additionally, said album comprises a photographically printed album"}.

As for claim 9, MORAG discloses an apparatus as defined in claim 8, further comprising an interlacer structured to generate a composite background image and a composite foreground image {See Column 7, Lines 41-42, wherein this reads over "background instructions, which determine the background to be printed on pages of the album"}.

As for claim 10, MORAG discloses an apparatus as defined in claim 9, wherein the interlacer is further structured to generate a composite interior image using the received digital image and the interior image stored in the memory device {See Column 5, Lines 17-20, wherein this reads over "the apparatus comprises an instruction store,

which stores instructions for arrangement, wherein said image arranger arrangers said images responsive to said instruction"}.

As for claim 11, MORAG discloses an apparatus as defined in claim 8, wherein the integration module is structured to:

retrieve a composite background image {See Column 9, Lines 49-51, wherein this reads over "labels may have a transparent background or they may have an opaque background"};

retrieve a composite foreground image {See Column 9, Lines 51-53, wherein this reads over "Transparent and/or opaque images may also be used between images, since the background of the album page usually also contains a pattern or an image"};

delete a portion of the composite background image to create a specialized background image, the portion of the composite background image deleted being dependant on the received digital image {See Column 10, Lines 41-43, wherein this reads over "after the images are correlated, the images in each group are combined to form a single combination image, by cutting and pasting of image portions"};

delete a portion of the received digital image to create a specialized interior image, the portion of the received digital image deleted being dependant on the composite foreground image {See Column 10, Lines 43-45, wherein this reads over "alternatively or additionally, images and/or image portions are enlarged, reduced and/or morphed to fit"}; and

digitally combine the specialized background image, the specialized interior image, and the composite foreground image to create the final composite image {See

Column 10, Lines 45-46, wherein this reads over "the seam between image portion are smoothed"}.

As for claim 12, MORAG discloses an apparatus as defined in claim 8, wherein the printer driver is structured to print a lenticular registration mark on the final composite image, the lenticular registration mark facilitating rotational positioning of the lenticular surface on the final composite image and axial positioning of the lenticular surface on the final composite image {See Column 11, Lines 3-4, wherein this reads over "the detail image is printed covering a portion of the overview image"}.

As for claim 13, MORAG discloses an apparatus as defined in claim 8, further comprising a network transmitter operatively coupled to the integration module, the network transmitter being structured to transmit a graphical representation of the final composite image to a client device via the Internet {See Column 6, Lines 34-35, wherein this reads over "an electronic proof copy of the album is optionally sent to the customer for approval"}.

As for claim 14, MORAG discloses an apparatus as defined in claim 13, wherein the graphical representation of the final composite image comprises data indicative of a plurality of two dimensional frames sequenced to produce a three dimensional illusion {See Column 6, Lines 42-44, wherein this reads over "the proof copy is maintained at a web site by the service provider, where the customer can browse the proof copy and enter comments"}.

As for claim 15, which has the same limitations as in claims 1 and 4, respectively, therefore, it is rejected for the similar reasons set forth in claims 1 and 4, respectively.

As for claim 16, which has the same limitation as in claim 2, therefore, it is rejected for the similar reason set forth in claim 2.

As for claim 17, which has the same limitation as in claim 3, therefore, it is rejected for the similar reason set forth in claim 3.

As for claim 18, MORAG discloses a method as defined in claim 15, further comprising the step of receiving a theme identifier, the theme identifier identifying one of the plurality of predetermined theme choices {See Column 2, Lines 43-45, wherein this reads over “the automatic arrangement and/or formatting instructions are preferably carried out in view of the selected theme”}.

As for claim 19, which has the same limitation as in claim 5, therefore, it is rejected for the similar reason set forth in claim 5.

As for claim 20, MORAG discloses a method as defined in claim 18, wherein a theme identified by the theme identifier includes the composite background image and the composite foreground image {See Column 7, Lines 41-42, wherein this reads over “background instructions, which determine the background to be printed on pages of the album”}.

As for claim 21, which has the same limitation as in claim 6, therefore, it is rejected for the similar reason set forth in claim 6.

As for claim 22, which has the same limitation as in claim 7, therefore, it is rejected for the similar reason set forth in claim 7.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 6,571,271 (SAVITZKY ET AL) is cited to teach a networked appliance for recording, storing and serving digital images,
- 2) U.S. Patent No. 5,924,870 (BROSH ET AL) is cited to teach a lenticular image and method, and
- 3) U.S. Patent No. 6,814,509 (ASHIZAKI) is cited to teach an image printing order receiving system and image printing order receiving method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
6/21/05



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